

REMARKS

The following issues are outstanding in the pending application:

- The drawings are objected to;
- The specification is objected to;
- Claim 13 is rejected under 35USC § 112;
- Claims 1-5, 7, 8, 10, and 12-14 are rejected under 35 USC 102;
- Claims 9 and 15 are rejected under 35 USC 103; and
- Claims 6 and 11 are rejected under 35 USC 103.

Specification amendments

Paragraph [0013] has been amended to define the conventional notation of “D (4,3)”. Paragraph [0026] has been amended to describe the reference numerals of 2b and 2c. No new matter has been added.

Claim amendments

Claims 1, 10, 12, and 15 have been amended to more clearly define the subject invention. Claim 1 now recites a process for the preparation of a coffee product comprising the step of compressing a roasted coffee in a roller press having at least one roller with a pocketed surface for forming compressed bodies of coffee. Independent claims 10, 12 and 15 include the same elements as amended claims 1. Claims 5 and 6 have been amended to conform to the amendment of claim 1. Claim 13 has been amended to more clearly define the particle size parameter. No new matter has been added.

Drawing objection

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include reference characters not mentioned in the description. Paragraph [0026] of the

specification has been amended to add the references characters 2b and 2c to the description. Applicant respectfully requests that this objection be withdrawn.

Specification objection

The specification is objected to because it does not include section headings. A specification in conformance with USPTO practice was filed on March 7, 2005 along with the other filing documents. A copy of the conforming specification is in PAIR in the Image File Wrapper section for the subject application having a Document Code of 371P.

35 USC § 112

Claim 13 is rejected under 35 USC 112, second paragraph as being indefinite for failing to particularly point out the subject matter of the instant invention. Claim 13 recites “having a particle size (e.g. D (4,3))”. The particle size parameter D (4,3) is conventional notation for the “volume moment mean” of the particles. Paragraph [0013] has been amended to define the “D (4,3)” nomenclature. Also a tutorial article titled “Particle Sizing – An Introduction” that explains this terminology is being submitted in a Supplemental IDS. Applicant respectfully requests that in view of the above, this rejection be withdrawn.

35 USC § 102

Claims 1-5, 7, 8, 10, and 12-14 are rejected under 35 USC 102(b) as having subject matter anticipated by U.S. Pat. No. 5,853,788 to Murphy et al. Applicant respectfully traverses this rejection.

Murphy teaches a flowable roasted and ground coffee product that is in the form of aggregates of granular roasted and ground coffee particles having a maximum X50 particle size of 270 .mu.m. The dense coffee mass is formed by subjecting roasted coffee to grinding between a grinding roll and a die member while simultaneously forcing the coffee as it is being ground through a plurality of die orifices in the die member. The grinding roll is urged under pressure towards the die member and is caused to move across a surface of the die member. The die member has a plurality of orifices or canals through which the coffee being ground is passed. The orifices are provided in the active surface of the die member, that is the surface which is traversed by the grinding roll.

A claim is anticipated only if each and every element as set forth in the claim is found either expressly or is inherently described in a single prior art reference. *Verdegaal Bros. v Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Applicant respectfully submits that nowhere does the Murphy reference teach or disclose a process for the preparation of a coffee product comprising the step of compressing a roasted coffee in a roller press having at least one roller with a pocketed surface for forming compressed bodies of coffee. The Murphy reference teaches forming the dense coffee mass by grinding roasted coffee between a grinding roll and a die member while simultaneously forcing the coffee as it is being ground through a plurality of die orifices in the die member. Therefore, Applicant respectfully asserts that since Murphy fails to teach or suggest each and every limitation of the presently amended independent claims 1, 10 and 12, a rejection under 35 U.S.C. 102(b) cannot be sustained. Since dependent claims 2-5, 13 and 14 depend at least in part on amended independent claim 1 or 12, they by definition are not anticipated by the Murphy reference. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection of claims 1-5, 7, 8, 10, and 12-14 under 35 USC 102 as having subject matter anticipated by U.S. Pat. No. 5,853,788 to Murphy et al.

35 USC § 103

Claims 9 and 15 are rejected under 35 USC 103(a) as having subject matter unpatentable over U.S. Pat. No. 5,853,788 to Murphy et al. Applicant respectfully traverses this rejection.

Regarding claim 9, Applicant respectfully submits that the previous discussion of the patentability of the current invention over Murphy obviates the present rejection. If an independent claim is non-obvious under 35 U.S.C. 103, than any claim depending therefrom is by definition nonobvious. *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Applicant respectfully asserts that because of its dependency from independent claim 1, claim 9 is nonobvious over this reference.

Regarding claim 15, *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), controls the consideration and determination of obviousness under 35 U.S.C. 103(a); *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734-35, 167 L. Ed. 2d 705, 715 (U.S. 2007). The four factual inquiries enunciated therein for determining obviousness are: (1) determining the

scope and contents of the prior art; (2) ascertaining the differences between the prior art and the claims in issue; (3) resolving the level of ordinary skill in the pertinent art; and (4) evaluating evidence of secondary considerations.

In this case, neither the level of ordinary skill in the art, nor secondary considerations are at issue. However, in order to assess the scope and content of the prior art properly, a thorough understanding of the invention must be acquired by studying Applicant's claims and the specification. M.P.E.P. § 2141. Thus, the inquiry begins with construction of Applicant's claims, explained below. Next, when ascertaining the differences between the prior art and the claims at issue, both the invention and the prior art references as a whole must be considered, and *all* claim limitations must be considered when determining patentability of Applicant's invention. M.P.E.P. §§ 2141; 2143. When this is properly done in this case, as shown below, it becomes clear that differences exist that preclude obviousness. And finally, the test for obviousness requires identification of a reasonable basis for combining the claimed elements in the claimed fashion. *KSR*, 127 S. Ct. at 1741; M.P.E.P. §2143. As shown below, this requirement is not met in this case, and no *prima facie* case for obviousness is made.

Applying the proper test to this case begins with amended independent claim 15 which requires a coffee brewing capsule containing a particulate coffee obtainable by a process comprising the steps of compressing a roasted coffee in a roller press having at least one roller with a pocketed surface for forming a compressed body of coffee and crushing the compressed body of coffee to form a particulate coffee product for placement in a brewing capsule. Instead of teaching a compressed body of coffee being formed by a roller press having at least one roller with a pocketed surface, the Murphy reference teaches forming the dense coffee mass by grinding roasted coffee between a grinding roll and a die member while simultaneously forcing the coffee as it is being ground through a plurality of die orifices in the die member. In order to make a proper *prima facie* case for obviousness, all claim limitations must be accounted for. M.P.E.P. § 2143.03. This rejection fails to consider all elements of the claim 15 and their meaning. Thus, claim 15 is erroneously rejected over the Murphy reference. Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection of claims 9 and 15 under 35 USC 103(a) as having subject matter unpatentable over U.S. Pat. No. 5,853,788 to Murphy et al.

Claims 6 and 11 are rejected under 35 USC 103(a) as having subject matter unpatentable over U.S. Pat. No. 5,853,788 to Murphy et al. in view of Perry et al. (ed.) (Perry's Chemical Engineers' Handbook 7th Edition, pages 20-82 through 20-84). Applicant respectfully traverses this rejection.

The Perry reference attached to the Office Action and the copy on PAIR are both unreadable. Applicant requests a readable copy of this reference. According to the Examiner, the Perry reference teaches that the roller press and pellet mill are both used to compress particulate (industrial) materials together and form pellets (and briquettes). According to the Examiner, Perry teaches that roller presses can produce large quantities [*sic* quantities] of materials at low cost. According to the Examiner, Perry teaches that the roller press had two pellets [*sic* presses] with pockets, wherein the pockets formed the shape of the pellets.

Regarding claim 6, the test for obviousness requires identification of a reasonable basis for combining the claimed elements in the claimed fashion. *KSR*, 127 S. Ct. at 1741; M.P.E.P. §2143. As shown below, this requirement is not met in this case, and no *prima facie* case for obviousness is made. The Action states that the reason for combining the elements is that it would be obvious to one of ordinary skill in the art to use a roller press comprising two pocketed rollers (taught by Perry) as the pellet mill as taught by Murphy in order to process large quantities of material at a low cost as taught by Perry.

The Examiner's rejection lacks valid reasoning because it is an attempt to justify a purely hindsight driven analysis. The Examiner has taken the Applicant's Specification and pieced together references, based on Applicant's Specification, rather than on the knowledge of one of ordinary skill in the art at the priority date. The Court has reaffirmed that this type of approach is illegal. *KSR* 127 S.Ct. at 1742. The Murphy reference is directed to providing flowable densified roasted and ground coffee products having a density higher than conventional roasted and ground and which has a brew yield which is at least equal to that of the coffee from which it is prepared. The entire description of the process for forming the Murphy product is directed to the use of a pellet mill. Murphy states that the preferred pellet mill has a capacity of 35 tons of pellets per hour (Col. 6, lines 53-55). Other than Applicant's use of a roller press with pockets, where is the motivation to process larger quantities of

material than can already be produced by the Murphy pellet mill, if in fact that is the case? Further, where is there evidence that using a roller press with pockets would be at a lower cost than the pellet mill used by Murphy? The Examiner's position implicitly assumes many things. While Applicant's disclosure of this counterintuitive and unexpected result makes the claimed method obvious in hindsight, the claims are not thereby rendered obvious under the proper legal criteria.

Regarding claim 11, Applicant respectfully submits that the previous discussion of the patentability of the current invention over Murphy obviates the present rejection. The Perry reference adds no new teaching to the Murphy reference that would result in the inventive method of amended independent claim 10. If an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending therefrom is by definition nonobvious. *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Applicant respectfully asserts that because of its dependency from independent claim 10, claim 11 is nonobvious over this reference. Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection of claims 6 and 11 under 35 USC 103(a) as having subject matter unpatentable over U.S. Pat. No. 5,853,788 to Murphy et al. in view of Perry et al. (ed.) (Perry's Chemical Engineers' Handbook 7th Edition, pages 20-82 through 20-84).

CONCLUSION

In view of the above, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2375, under Order No. HO-P03144US0 from which the undersigned is authorized to draw.

Dated: February 21, 2009

Respectfully submitted,

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